

Rejections under 35 U.S.C. § 102

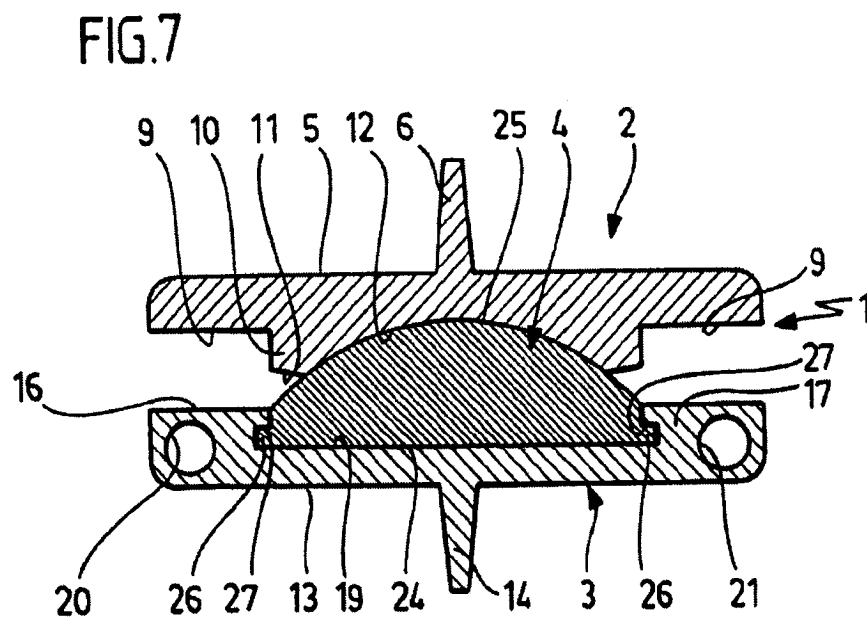
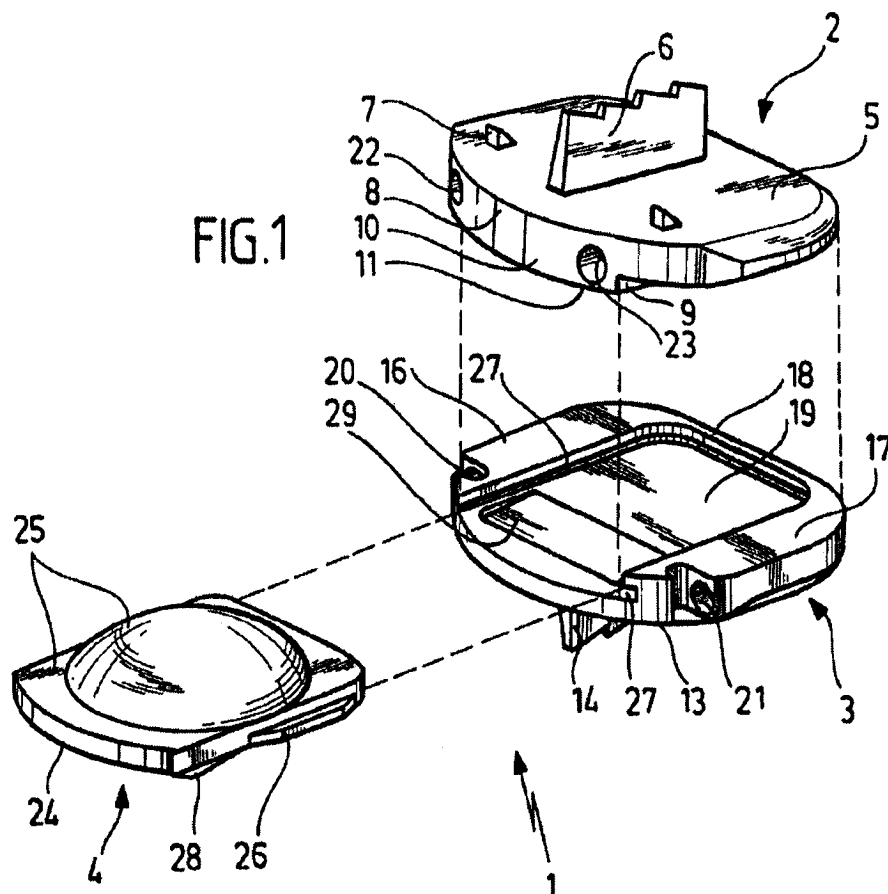
The Office Action indicated that **claims 1, 2, 5, 7-10, 13-22, 25, 27-30, and 37-39** are rejected under 35 U.S.C. §102(b) as being anticipated by WO 01/01893 to Marnay et al. (“the Marnay application”). Applicants have considered U.S. Patent No. 6,936,071 as the English translation of the Marnay application.

The PTO provides in MPEP §2131 that

“[t]o anticipate a claim, the reference must teach every element of the claim . . .”

Therefore, to sustain the rejections of claims 1, 2, 5, 7-10, 13-22, 25, 27-30, and 37-39 the Marnay application must teach all of the claimed elements of each claim.

With respect to independent claim 1, the Marnay application at least fails to teach, “a projection extending from a first articular surface, the projection being offset relative to the first articular surface ... a recess formed in a second articular surface, the recess being offset relative to the second articular surface thereby accommodating a spondylosed relationship between a first vertebra and a second vertebra adjacent to the first vertebra, wherein the projection and the recess engage one another to provide for articulating motion between the first and second components.” In that regard, as shown in Figures 1 and 7 reproduced below, the parts 2 and 3 of the Marnay application are configured to be substantially aligned, as indicated by the dotted lines. To that end, the spherically upwardly-curved topside 25 of the pivot insert 4 is centrally positioned and configured to mate with the centrally positioned concave spherical indentation 12 of the upper part 2.



As shown, the implant 1 of the Marnay application does not include a projection offset relative to the first articular surface articulatingly engaged with a recess offset relative to the second articular surface surface, thereby accommodating a spondylosed relationship between a first vertebra and a second vertebra adjacent to the first vertebra, as required by claim 1.

For at least these reasons the Marnay application fails to teach all of the claimed elements of independent claim 1. Claims 2, 5, and 7-10 depend from and further limit independent claim 1. Therefore, Applicants respectfully request that the §102 rejection of claims 1, 2, 5, and 7-10 be withdrawn.

With respect to independent claim 13, the Marnay application at least fails to teach, "wherein one of the first and second components comprises a projection and the other of the first and second components comprises a recess, the projection and recess being adapted to engage one another, and wherein one of the projection and the recess is offset relative to the other of the projection and the recess to accommodate a spondylosed relationship between the first and second vertebrae." As discussed above with respect to claim 1, the parts 2, 3 and insert 4 of the implant 1 of the Marnay application are configured to be substantially aligned. The Marnay application simply does not disclose a prosthetic device having components with offset projection and recess to accommodate a spondylosed relationship between vertebrae as required by claim 13.

For at least these reasons the Marnay application fails to teach all of the elements of independent claim 13. Claims 14-22, 25, 27-30 depend from and further limit claim 13. Therefore, Applicants respectfully request that the §102 rejection of claims 13-22, 25, 27-30 be withdrawn.

With respect to independent claim 37, the Marnay application at least fails to teach, "longitudinally inserting the first articular component into a first vertebra and longitudinally inserting the second articular component into a second vertebra, the second vertebra being adjacent to and in a spondylosed relationship with the first vertebra." The Marnay application simply does not disclose a inserting articular components of a prosthetic device between adjacent vertebrae that are in a spondylosed relationship. This is consistent with the fact that the parts 2, 3 and insert 4 of the implant 1 of the Marnay application are configured to be substantially aligned.

For at least these reasons the Marnay application fails to teach all of the recited elements of claim 37. Claims 38 and 39 depend from and further limit claim 37. Therefore, Applicants respectfully request that the §102 rejection of claims 37-39 be withdrawn.

Rejections under 35 U.S.C. § 103

The Office Action indicated that **claims 3, 4, 6, 23, and 24** are rejected under 35 U.S.C. §103(a) as being unpatentable over the Marnay application. Applicants respectfully traverse the rejection of these claims on the grounds that a *prima facie* case of obviousness has not been established.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that the examiner has not factually supported a *prima facie* case of obviousness with respect to claims 3, 4, 6, 23, and 24 in the present case.

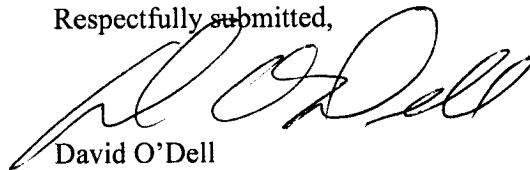
Claims 3, 4, and 6 depend from and further limit independent claim 1. Claims 23 and 24 depend from and further limit independent claim 13. As shown above, the Marnay application fails to disclose all of the elements of independent claims 1 and 13. Therefore, for at least the same reasons the Marnay application also fails to disclose all of the elements of claims 3, 4, 6, 23, and 24. Thus, Applicants request that the §103 rejection of claims 3, 4, 6, 23, and 24 be withdrawn.

IV. Conclusion

Applicants believe that all matters set forth in the Office Action have been addressed and that claims 1-10, 13-30, and 37-39 are in condition for allowance. An early formal notice of allowance is requested.

Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration of the present application, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date: August 13, 2007

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